

deflating the inflatable member sufficiently to allow passage of a surgical tool through said inner bore of the sealing device while substantially maintaining a seal between said inflatable membrane and said surgical tool; and
performing a surgical procedure through the incision with said surgical tool.

REMARKS

In an Office Action dated September 12, 2000, the Examiner rejected claims 1-7, 9-13, and 15 of the instant application under 35 U.S.C. § 103(a), first paragraph. Specifically, the Examiner took the position that these claims were unpatentable over U.S. Pat. No. 5,366,478 to Brinkerhoffer et al. in view of either U.S. Pat. No. 5,273,545 to Hunt or U.S. Pat. No. 5,226,890 to Ianniruberto et al.

Although claims 12-14 were objected to by the Examiner, the Examiner indicate that the subject matter of claim 14 would be allowable¹ if properly rewritten so that claim 9 incorporated the limitations of claim 14. Claim 8 was not rejected or objected to on any basis by the Examiner, and considering its similarity to claim 14, Applicants presume that claim 1 is allowable as well if rewritten to incorporate all the limitations of claim 8 and any intervening claims.

¹ Although the Examiner used the term "favorable," Applicants assume that the Examiner uses this term interchangeably with "allowable."

A. Allowable Subject Matter

As indicated above, the Examiner appears to have agreed that the subject matter of dependent claims 8 and 14 are allowable if rewritten in independent form and incorporating all the limitations of any intervening claims. Accordingly, as requested by the Examiner, claims 1 and 9 have been amended to incorporate the limitations of claims 8 and 14, respectively, and are now in condition for allowance for that reason.

Thus, Applicants respectfully submit that claims 1 and 9, as amended are patentable to Applicants over the prior art cited by the Examiner and the prior art of record. Further, pending claims 2-7, 9-13, and new claims 16 and 17 all depend from either amended claim 1 or amended claim 9, and are allowable for at least the same reasons as the claims from which they depend. Because claims 2-7, 9-13, and 16 and 17 merely add further limitations to the subject matter of previously presented claims 8 and 14, which subject matter the Examiner indicated was allowable in the most recent office action, entry of these amendments and allowance of these claims is appropriate.

B. Objection to Claims 12 – 14 Under 37 C.F.R. § 1.75(c)

As noted above, claim 14 has been cancelled and the subject matter of claim 14 has been claimed in independent claim 9, thus obviating any objection to this claim under 37 C.F.R. § 1.75(c). Also, claims 12 and 13 have been rewritten to properly claim dependency from amended claim 9. Accordingly, these claims are believed to be in condition for allowance and it is requested that the Examiner's objection to these claims be withdrawn.

C. Rejection of Claims 2-5, 9-11, And 15 Under 35 U.S.C. § 112[2]

Applicants respectfully point out that the claims 2, 5, and 9 do have proper antecedent basis for the term "said outer surface of said tube" appearing in these claims. Particularly, each claim recites the antecedent step of "providing a sealing device comprising **a tube having . . . an outer surface.**" Accordingly, the phrase "said outer surface of said tube" properly refers back to this claim limitation. As for rejected claim 5, claim 5 depends from claim 1 and does not contain the claim language objected to by the Examiner. The Examiner is invited to contact Applicants' representative if the Examiner has a preferred manner of writing this limitation in order to cure any perceived defect by Examiner's Amendment, however, Applicants assert that these claims appear to be correct as written.

Claim 15 has been cancelled, thus mooting any alleged defect under 35 U.S.C. § 112[2].

D. Double Patenting Rejection

Applicants submit herewith a terminal disclaimer in compliance with 35 U.S.C. § 1.321(c) disclaiming the terminal part of any patent granted hereon extending past the natural expiration of U.S. Pat. Nos. 5,964,781 and 5,997,515, thus obviating the Examiner's rejection on this basis.

CONCLUSION

For all the foregoing reasons, Applicants respectfully submit that the claims are now in condition for allowance. Entry of the foregoing amendments and favorable action on the merits of the claims is therefore earnestly solicited. If any minor issues remain, please contact Applicants' undersigned representative at 949-567-2300. It is believed that no additional fees

are required in connection with this amendment; however, the Patent Office is authorized to charge any fees which may be due to Deposit Account No. 12-2475.

Respectfully submitted,

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Dated: 12/11/00

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